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PATENT APPLICATION  
PO7955  
HE-178

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICATION OF )  
MARTIN SCHAMBERG ET AL ) GROUP ART UNIT: 1796  
SERIAL NUMBER: 10/800,908 ) EXAMINER: John M. Cooney  
FILED: March 15, 2004 )  
TITLE: PROCESS FOR THE PRODUCTION )  
OF POLYURETHANE FOAMS )

**REPLY BRIEF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The Examiner's Answer dated November 1, 2007 has been received and its contents noted. The following is in response thereto.

I hereby certify that this correspondence is being deposited  
with the United States Postal Service as first class mail in an  
enveloped addressed to: Commissioner for Patents,  
Alexandria, VA 22313-1450 January 2, 2008

Date

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Name of applicant, assignee or Registered Representative



Signature

January 2, 2008

Date

## **REMARKS**

- I. The Examiner has argued at page 6 of his Answer that Appellants do not differentiate their apparatuses from the combined teachings of the prior art.

Appellants respectfully disagree and would direct the Board's attention to page 6 of their Brief where it is stated:

This "obvious" apparatus generated from the combined teachings of the cited references does not, however, correspond to or render obvious Appellants' claimed apparatus in which (1) the filler must be comminuted before being combined with a liquid reaction component and (2) the filler-containing liquid reaction component is passed through a filter before that filler-containing component is combined with the other reaction components.

The Examiner's argument does not therefore support the rejection of Appellants' claimed invention.

- II. The Examiner has also argued that the fine mesh screen of Eiben et al meets the definition of filter as defined by Appellants' claims. (at page 6 of the Examiner's Answer)

Appellants would note, however, that they are not claiming a filter, *per se*. Appellants are claiming an apparatus which includes a filter that must be positioned at a particular location within that apparatus so that it can serve the function taught in Appellants' specification.

The Examiner's argument does not therefore support the rejection of Appellants' claims.

- III. The Examiner has also argued that Appellants' arguments are unpersuasive because they relate to processing effects that relate to the intended use of the apparatus involved. (at page 6 of the Examiner's Answer)

Appellants submit that the significance of differences between the prior art and a claimed apparatus is one of the elements which must be considered in evaluating the obviousness of an invention.

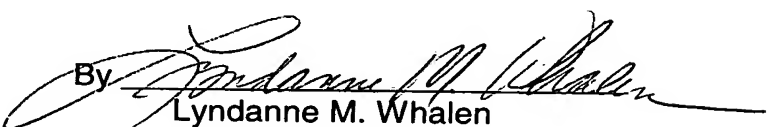
The obviousness of the invention **as a whole** must be evaluated. Therefore, the functional significance of the differences between Appellants' claimed apparatus and each apparatus disclosed in the prior art must be considered in determining the obviousness of the presently claimed invention. The fact that an element such as a filter is positioned at a location not taught by the prior art to serve a function which is not taught by the cited prior art, is therefore relevant to the determination of the obviousness of Appellants' claimed invention.

The Examiner's argument does not therefore support the rejection of Appellants' claimed invention.

For these reasons and those discussed in their Brief, Appellants continue to maintain that the Examiner's rejection of Claims 17-35 under 35 U.S.C. §103(a) is in error and respectfully request that this rejection be reversed and that Claims 17-35 be allowed.

Respectfully submitted,

By

  
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